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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,348	09/05/2003	Yukiko Kubota	SEAG 61977	7814
7590 04/14/2005  Benjamin T. Queen, II  Pietragallo Bosick & Gordon  One Oxford Centre, 38th Floor  301 Grant Street  Pittsburgh, PA 15219			EXAMINER	
			BERNATZ, KEVIN M	
			ART UNIT	PAPER NUMBER
			1773	
			DATE MAILED: 04/04/2005	

Please find below and/or attached an Office communication concerning this application or proceeding.

			the n			
		Application No.	Applicant(s)			
Office Action Summary		10/656,348	KUBOTA, YUKIKO			
		Examiner	Art Unit			
		Kevin M Bernatz	1773			
Period fo	The MAILING DATE of this communication app or Reply	ears on the cover sheet with the	correspondence address			
THE - Exte after - If the - If NC - Failu Any	ORTENED STATUTORY PERIOD FOR REPLY MAILING DATE OF THIS COMMUNICATION. Insions of time may be available under the provisions of 37 CFR 1.13 SIX (6) MONTHS from the mailing date of this communication. It is period for reply specified above is less than thirty (30) days, a reply opened for reply is specified above, the maximum statutory period we are to reply within the set or extended period for reply will, by statute, reply received by the Office later than three months after the mailing ed patent term adjustment. See 37 CFR 1.704(b).	36(a). In no event, however, may a reply be to within the statutory minimum of thirty (30) davill apply and will expire SIX (6) MONTHS from cause the application to become ABANDON	imely filed  ys will be considered timely.  n the mailing date of this communication.  ED (35 U.S.C. § 133).			
Status						
	Responsive to communication(s) filed on					
·	, <del></del>	action is non-final.				
3)	Since this application is in condition for allowance except for formal matters, prosecution as to the merits is					
	closed in accordance with the practice under E	x parte Quayle, 1935 C.D. 11, 4	·53 O.G. 213.			
Dispositi	ion of Claims					
4)⊠	Claim(s) 1-21 is/are pending in the application.	•				
	4a) Of the above claim(s) is/are withdrawn from consideration.					
5)	Claim(s) is/are allowed.					
6)	Claim(s) is/are rejected.					
7)	Claim(s) is/are objected to.					
8)⊠	Claim(s) <u>1-21</u> are subject to restriction and/or e	election requirement.				
Applicati	ion Papers					
9)[	The specification is objected to by the Examine	r.				
10)☐ The drawing(s) filed on is/are: a)☐ accepted or b)☐ objected to by the Examiner.						
,—	Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).					
	Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).					
11)	11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.					
Priority ı	under 35 U.S.C. § 119	•				
_	•	priority under 35 U.S.C. & 110/-	a) (d) or (f)			
12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) All b) Some * c) None of:						
۵۸۱	1. Certified copies of the priority documents have been received.					
	2. Certified copies of the priority documents have been received in Application No					
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).						
* See the attached detailed Office action for a list of the certified copies not received.						
Attachmen	t(e)					
	e of References Cited (PTO-892)	4) Interview Summar	v (PTO-413)			
2) Notic	e of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail D	Date			
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  Paper No(s)/Mail Date  5) Notice of Informal Patent Application (PTO-152)  6) Other:						
. upo		v, <u> </u>				

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## **DETAILED ACTION**

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## Election/Restrictions

- 1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - Claims 1 8, drawn to a thin film structure, classified in class 428, subclass 692.
  - II. Claims 9 16, drawn to a magnetic recording medium using a thin film structure, classified in class 428, subclass 694TS.
  - III. Claims 17 21, drawn to a perpendicular recording system including a perpendicular magnetic head and a recording medium using a thin film structure, classified in class 360, subclass 131.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as part of a magnetic head and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of

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the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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- 3. Inventions I and III are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as part of a magnetoresistive head instead of part of a recording medium and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.
- 4. Inventions II and III are related as product and apparatus using the product (i.e. "process of use"). The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in another and materially different process of use, namely in combination with a longitudinal magnetic recording head.

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5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. No telephone call was made to applicants due to the complexity of the restriction requirement. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

## Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin M Bernatz whose telephone number is (571) 272-1505. The examiner can normally be reached on M-F, 9:00 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KMB April 1, 2005

Kevin M. Bernatz, PhD Brimary Examiner